

### **REMARKS/ARGUMENTS**

The Office objected to the declaration as defective because "it does not identify the foreign country of residence of each inventor." In particular, the inventor mistook the word "Country" for "County" and entered "AA" as a common abbreviation for Anne Arundel county, his county of residence in Arnold, Maryland, USA. Applicant submits herewith a supplemental declaration with his country of residence correctly identified as US.

Claims 1-8, 13-14, and 19 stand rejected under 35 U.S.C. 102(b) as being anticipated by Rioux et al. (U.S. 2004/0236356). As observed in the Office action, 35 U.S.C. 102(b) states that "[a] person shall be entitled to a patent unless...the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States."

According to MPEP § 706.02(a)(II)(A), "[i]f the publication or issue date of a reference is more than one year prior to the effective filing date of the application (MPEP § 706.02), the reference qualifies as prior art under 35 U.S.C. 102(b)." However, the publication date of U.S. 2004/0236356 was 11/25/2004, and no reference is made to continuity with an earlier application. The filing date of the instant application was 11/26/2003. U.S. 2004/0236356 was published almost one year *after* the effective filing date of the instant application and cannot therefore qualify as prior art under 35 U.S.C. 102(b).

Moreover, the instant application and Rioux et al. describe patentably distinct inventions. Neither claim set reads on the other invention. The instant application describes and claims a suturing device comprising a body, a needle attached to the body, and a moveable arm that masks the tip of the needle. The needle is fixed with respect to the body, the arm moves. The needle can take many different shapes. The mechanism that moves the arm is on and within the body.

In contrast, Rioux et al. describes and claims a head attached to an elongated body member, with a needle, a needle driver, and a needle catch within the head. The head masks the needle and needle driver until a plunger at the opposite end of the body is actuated, causing the needle driver and attached needle to slide out of the head in an arc. The needle moves; the mask remains fixed. The arc of needle driver causes the needle to swing back into the head through the needle catch. The needle separates from the needle driver and is retained by the needle catch as the needle driver is withdrawn.

In short, Rioux et al. describes and claims a completely different mechanism using a different method to effect a suture. Rioux et al. describes no counterpart to the masking arm of the instant application. The instant application has no counterpart to the needle driver. Rioux et al. describes a short needle that detaches from the needle driver while in use. The instant application describes a long needle that remains affixed to the body while in use. Indeed, as described in paragraphs four and five of the instant application, sliding a needle into and out of a block of material that is inserted into an incision is one of the solutions that the apparatus of instant application attempts to avoid.

Finally, claims 9-12 and 15-18 stand rejected under 35 U.S.C. 103(a) as unpatentable over Rioux et al. in view of Greenstein (U.S. 5,964,773). However, as observed above, U.S. 2004/0236356 is not available as 103(a) prior art via 35 U.S.C. 102(b), and in any event Rioux et al. describes and claims a patentably distinct invention. Even if combined with Greenstein, Rioux et al. does not teach or suggest the claim limitations of the instant application.

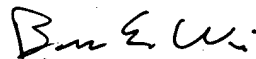
Further, a person of ordinary skill in the art would have no motivation to combine Rioux et al. with Greenstein to produce the apparatus of the present application, nor does either Rioux et al. or Greenstein suggest such a combination, because Rioux et al. describes and claims a completely different mechanism using a different method to effect a suture than does the instant application. The user of the apparatus of the instant application grasps the body in one hand and changes the position and orientation of the body to manipulate a needle fixed to the body. The depressions assist such manipulations by providing a secure grip. The T-shaped handle described by Rioux et al. is attached the

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proximal end of an elongated, flexible body and serves to react pressure applied to a plunger. The depressions shown by Greenstein are unnecessary for the apparatus of Rioux et al.

Since Rioux et al. does not anticipate the apparatus of the instant application and the Office has not established a *prima facie* case of obviousness within the meaning of 35 U.S.C. 103(a), Applicant respectfully requests that the rejections be reconsidered and withdrawn, and that a timely Notice of Allowance be issued in this case.

Respectfully submitted,



Bruce E. Weir  
Reg. No. 48,191  
Tel.: (301) 977-6009

Attachments: Supplemental Declaration (2 pages)  
PTO-2038 (1 page)

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